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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/678,271 | 10/06/2003 | Masaaki Sekine | Q77763 | 3456 |

23373 7590 04/15/2004

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EXAMINER

MCANULTY, TIMOTHY P

ART UNIT

PAPER NUMBER

3682

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/678,271

Applicant(s)

SEKINE

Examiner

Timothy P McAnulty

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19, 21-24, 27, 28 and 30-33 is/are rejected.
- 7) ☐ Claim(s) 20, 25, 26, 29, 34 and 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/471,232.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 06 October 2003 contains reference SU 3943191 which was not filed in either application 09/859,044 or 09/471,232. Accordingly, reference SU 3943191 has not been considered and has been lined through on the Form 1449.

Drawings

2. Figure 15 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. The abstract of the disclosure is objected to because it contains more than 150 words. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 19-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation of "relatively approaching" in line 7 of claim 19, in line 7 of claim 20, in line 7 of claim 29, and line 8 of claim 27 renders the respective claims indefinite. It is unclear as to what "relatively approaching" limits the claimed invention. For the purposes of this Office

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action, the limitation is being construed to mean the lubricant discharge nozzle and the rolling element mover towards one another by way of the control unit.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 19, 27 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Larke et al. Larke et al. discloses in figure 2, a lubricant applying apparatus comprising a rotating table 24,26; a roller bearing 2 disposed on said table; a discharge nozzle 31; a discharge port 40; a pump 88; a convex engagement portion 28 engaging a concave portion 27 of said rolling bearing; and an inherent control unit to move said nozzle and said rolling element towards one another (see lines 35-43 of column 2).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 24 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larke et al. in view of Smith et al.

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Larke et al. discloses the basic apparatus as previously cited but does not disclose a sensor detecting a position of said rolling element. However, Smith et al. teachings in figures 1-2 and in lines 9-42 of column 3, a bearing lubricator comprising, *inter alia*, a sensor detecting a position of a rolling element during rotation of said bearing. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Larke et al. in view of the teachings of Smith et al. to provide a sensor so as to detect the position of said rolling element relative to said nozzle so as to determine the radial rotation of said roller bearing.

10. Claims 21 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larke et al. in view of Endo et al.

Larke et al. discloses the basic apparatus as previously cited but does not disclose said nozzle being treated with an oil repellent treatment. However Endo et al. teaches in figure 6 and in lines 1-3 of column 13, a lubricating nozzle having an oil repellent treatment thereon.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Larke et al. in view of the teachings of Endo et al. to treat the nozzle with an oil repellent so as to prevent the lubricant from leaking from the nozzle and wetting the external surface of said nozzle.

11. Claims 22 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larke et al.

Larke et al. discloses the basic apparatus as previously cited but does not disclose a plurality of ports equal in number to a number of rolling elements. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a plurality of discharge ports equal to a number of rolling elements, since it has been held that

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mere duplication of the essential working parts of a device involves only routine skill in the art.

St. Regis Paper Co. v. Bemis Co., 193 USPQ 8 (CCPA 1977).

12. Claims 23 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larke et al. in view of Gerhardt.

Larke et al. discloses the basic apparatus as previously cited but does not disclose a filter filtering said lubricant. However, Gerhardt teaches I figure 1, a lubricating apparatus comprising, *inter alia*, a filter 114 in said lubricant line. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Larke et al. in view of the teachings of Gerhardt to provide a filter filtering said lubricant so as to remove impurities within said lubricant before said lubricant is supplied to said bearing.

Allowable Subject Matter

13. Claims 20,25,26,29,34, and 35 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The prior art discloses or teaches the basic apparatus as set forth above but does not disclose or teach the specific control unit adjusting the position of the table. Although the prior art teaches control units for discharging lubricant based on sensed conditions of a bearing, those control units are used to lubricate bearings which rotate on a shaft, i.e., those control units do not adjust the rotation of the bearing table. Additionally, the claimed apparatus is too specific in structure or operation to be rejected as being obvious to make a manual operation automatic. *See In re Venner*, 120 USPQ 192.

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Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art regarding lubricant applicators in general:

US Patent No. 4,284,174 to Salvana et al.

US Patent No. 5,080,195 to Mizumoto et al.


15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy P McAnulty whose telephone number is 703.308.8684. The examiner can normally be reached on Monday-Friday (7:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 703.308.3668. The fax phone number for the organization where this application or proceeding is assigned is 703.872.9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.1113.

tpm

08 April 2004


DAVID A. BUCCI
SUPERVISORY PATENT EXAMINER
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